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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,084	03/12/2004	Greg Siwak	10759-00048	8523

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EXAMINER
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POLLICOFF, STEVEN B

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/799,084	<b>Applicant(s)</b> SIWAK ET AL.	
	<b>Examiner</b> Steven B. Pollicoff	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 22-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group I in the reply filed on 7/21/06 is acknowledged. The traversal is on the ground(s) that "storing" of the product package is not a materially different process than the reusing of the package and the packing/unpacking of food/non-food items in and out of the package. As to claims 22 - 31, Applicant's arguments are not found persuasive because storing of the product package in a locker or refrigerator is clearly a materially different process than reusing the package or presenting the package at a point of purchase. Additionally, a thorough search of either Group would not encompass the other one and therefore creates an undue burden on the examiner. The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Franco et al., (US Pat 4,506,769).

With respect to claims 1-5,7,8,10 and 11, Franco discloses a dual use product package/duffel bag (Franco Fig 1) comprising a non-food product/footwear (Fig 4); a

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non-rigid rectangular base (column 2 lines 65-68) defining a cavity capable of being used as a lunchbox (Fig 3) holding said non-food product and capable of containing a food product (i.e. edible food , beverage, etc...) once the nonfood product is removed; a cover (18) configured to close said cavity; and a closure member located at or near a top edge of said base (24) (i.e. zipper mechanism) fastening said cover to said base; and a handle attached to said base (26).

With respect to claim 6, Franco discloses that said cover is integrally formed with said base, said cover folded over said base in a closed position (Fig 3 ref 22).

With respect to claim 9, Franco discloses that the package includes an expandable section to hold food/non-food items in the cavity (Fig 4 ref 70).

With respect to claim 12, Franco discloses that a portion of the base is insulated (Fig 3 ref 41; see also column 4, lines 46-49).

With respect to claims 13,14,16 and 17, Franco discloses a footwear package comprising: a support surface (Fig 3 see bottom surface of base ref 10); a plurality of soft side walls (Fig 3 see also column 2, lines 65-68) extending from said support surface and defining a cavity (Fig 3 generally) comprising footwear (Fig 4), wherein at least one of said side walls comprises a flap (18) folded over the remaining side walls to define a cover over said cavity; and a zipper (24) selectively coupling and uncoupling said flap and said remaining side walls at or near the top edge of the support surface; and a handle (26).

With respect to claim 15, Franco discloses that at least one of said support surface and said side walls comprises a soft material and a stiffening element (column 5, lines 30-35).

With respect to claims 18 and 19, in order to further limit the claims there must be some distinction based upon the intended use recited. "However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art." (see M.P.E.P. § 2111.02 THE INTENDED USE MAY FURTHER LIMIT THE CLAIM IF IT DOES MORE THAN MERELY STATE PURPOSE OR INTENDED USE.) The examiner can see no structural differences between the claimed invention and the prior art based upon the intended use recited of the cavity being "packed with footwear at a point of purchase" and being "packed with footwear at a first point in time and packed with lunch items at a second point in time." Therefore, the claims are rejected for not further limiting the independent claim 13.

With respect to claims 20 and 21, Franco discloses the package further comprising an expandable section (Fig 4 ref 70) and that the base is convertible into a duffel bag (Fig1 and Fig 4).

Claims 1-6 and 8-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Davis (US Pat 4,334,601).

With respect to claims 1-5, Davis discloses a dual-use product package comprising: a non-food product (Davis column 4, lines 9-16); a non-rigid rectangular

base (Fig 4 reference letters A, B and C combined) defining a cavity (BR plus interior compartments of A and C not shown) holding said non-food product; a cover (BT) configured to close said cavity; and a closure member located at or near a top edge of said base (32) (i.e. zipper mechanism) fastening said cover to said base; and a handle attached to said base (16A).

With respect to claim 6, Davis discloses that said cover is integrally formed with said base, said cover folded over said base in a closed position (Fig 4; see also Fig 2 and 6).

With respect to claim 8, 10 and 12, Davis discloses that the cavity, including a portion of the base and cover, is adapted for use as an insulated lunchbox/cooler storing at least a beverage (column 3, lines 34-45; see also column 4, lines 9-16).

With respect to claims 9 and 20, Davis discloses that the package includes an expandable section configured to hold either said non-food product in said cavity or a non-food product different from said non-food product in said cavity (column 3, lines 17-24; see also Fig 4 reference letter AS).

With respect to claims 11 and 21, Davis discloses that the package is convertible into a duffel bag (Fig 4 generally; see also column 1 lines 16-21)).

With respect to claim 13 and 14, Davis discloses package comprising: a support surface (Fig 4 see bottom surface of reference letter A); a plurality of soft side walls (AS) extending from said support surface and defining a cavity (A; see also column 4, lines 9-16), wherein at least one of said side walls comprises a flap (AW; see also

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column 3, lines 28-33) folded over the remaining side walls to define a cover over said cavity; and a zipper (30) selectively coupling and uncoupling said flap and said remaining side walls; and a handle (16A).

With respect to claim 15, Davis discloses that at least one of said support surface and said side walls comprises a soft material (i.e. collapsible fabric) and a stiffening element (Fig 4 reference number 12A i.e. stitching seams).

With respect to claim 16, Davis discloses that the zipper mechanism is located at or near a top edge of said base (Fig 7 not labeled but seen just above reference number 36A).

With respect to claims 18 and 19, in order to further limit the claims there must be some distinction based upon the intended use recited. "However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art." (see M.P.E.P. § 2111.02 THE INTENDED USE MAY FURTHER LIMIT THE CLAIM IF IT DOES MORE THAN MERELY STATE PURPOSE OR INTENDED USE.) The examiner can see no structural differences between the claimed invention and the prior art based upon the intended use recited of the cavity being "packed with footwear at a point of purchase" and being "packed with footwear at a first point in time and packed with lunch items at a second point in time." Therefore, the claims are rejected for not further limiting the independent claim 13.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis (US Pat 4,334,601).

With respect to claims 7 and 17, while not explicitly disclosing that the non-food product is footwear, Davis does disclose that the product package cavity holds athletic equipment such as a soccer ball and thus it is reasonable to conclude that the utility bag can hold other athletic equipment such as footwear (column 4, lines 9-16).

***Response to Arguments***

Applicant's arguments filed 7/21/06 have been fully considered but they are not persuasive. Applicant argues that Davis nowhere discloses the utility bag as a product package as the term is used in the specification and claims. This is no persuasive



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because the claim preamble must be read in the context of the entire claim. The determination of whether preamble recitations are structural limitations or mere statements of purpose or use "can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim." *Corning Glass Works*, 868 F.2d at 1257, 9 USPQ2d at 1966. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). In the instant case, Applicant's disclosure provides only that the product packaging essentially serves as a housing for an item to be removed and that the packaging may be reused to package/house another item. Therefore, it is reasonable to conclude that the preamble is not considered a limitation and is of no significance to claim construction since the claim fully and intrinsically sets forth all of the limitations of the claimed invention.

Applicant also argues that Davis does not disclose compartment B used in connection with non food items or that either the compartments A or C are described in connection with both food and non-food items. This is unpersuasive because Examiner rejected claim 1 showing that Davis had a cavity that included compartments A,B and C, collectively. When taken together, the cavity (composed of compartments A,B and C) is used in connection with food and non-food items. Additionally, it has been held that the

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recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. Thus, it is reasonable to conclude that any one of compartments A,B or C has the ability to perform the intended function (i.e. contain food/non-food items).

Applicant further argues that Davis does not teach a non-rigid base. This is unpersuasive because in as much as Applicant discloses/defines a “non-rigid” base, it is reasonable to at least think that the polyurethane foam is non-rigid in the sense that foams have forgiving, deformable surfaces.

Applicant’s argument with respect to Davis not anticipating footwear is found persuasive and the rejection is withdrawn.

Applicant argues Davis does not anticipate the invention “adapted for use as a lunchbox”. This is unpersuasive because Davis discloses a compartment to hold food items certainly capable of being used as a lunchbox. Additionally, it has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. In the instant case there is no question that the Davis invention can perform the function.

Applicant argues that Davis does not disclose anything being packaged (including footwear) within the meaning of the claimed invention and that the Davis utility bag is not well suited for packing footwear. This is unpersuasive because Davis does disclose items being packaged, more specifically, athletic equipment and

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beverages (Davis column 3, lines 38-39 and column 4, lines 12-13). Regardless of the suitability of the package for footwear, the Davis bag is certainly capable of packaging footwear whether or not Applicant considers it suitable for that purpose.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. Pollicoff whose telephone number is (571)272-7818. The examiner can normally be reached on M-F: 7:30A.M.-4:00P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571)272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SBP 10/02/06



JILA M. MOHANDESI  
PRIMARY EXAMINER

10/02/06